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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/762,699

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Bernd-Georg Pietras

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8491

7590

06/04/2004

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EXAMINER

OMGBA, ESSAMA

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/762,699

**Applicant(s)**

PIETRAS, BERND-GEORG

**Examiner**

Essama Omgba

**Art Unit**

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-9 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,11-24 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a "mud pipe" (fluid conduit) between a plate and a supporting member, does not reasonably provide enablement for "a fluid conduit for fluid communication between the top drive and the tubular gripping apparatus". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Applicant has substituted the phrase "fluid conduit" for the phrase "mud pipe" as originally claimed in claims 7 and 8, then if "fluid conduit" is equivalent to "mud pipe" as understood by the examiner, the fluid conduit does not allow for fluid communication between the top drive and the tubular gripping apparatus.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear whether the "fluid conduit" in claim 21 is the same claimed in claims 7 and 8, which was formerly claimed as "mud pipe".

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5-8, 12-16, 20-24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Boyadjieff (US Patent 4,625,796).

With regards to claims 1 and 2, Boyadjieff discloses an apparatus for facilitating the connection of tubulars using a top drive 19, the apparatus comprising a plate 44 attachable to the top drive, a supporting member 84 for supporting a tool 42 and a motive member (158, 121, 154) for allowing substantially horizontal and vertical movements of the supporting member, see column 1, lines 36-68, column 2, lines 1-9, column 10, lines 11-64 and figures 8, 10, 11 and 14.

For claim 3, see column 8, lines 27-51.

For claim 5, see column 7, lines 16-23.

For claim 6, see column 5, lines 34-38.

For claims 7 and 8, element 49 in figure 2 represents a fluid conduit that rotates and is movable.

For claims 12 and 13, see column 6, lines 1-37.

For claims 14 and 16, Boyadjieff discloses a method for facilitating the connection of tubulars using a top drive 19, the method comprising attaching a tool 42 to the top drive using a supporting member 84 and adjusting the supporting member to cause the tool

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to be displaced horizontally relative to the top drive, see column 1, lines 36-68, column 2, lines 1-9 and column 10, lines 11-64.

For claim 15, see column 9, lines 6-23.

For claim 20, Boyadjieff discloses a top drive system for connecting tubulars comprising a top drive 19, a tubular gripping apparatus 84 and a structural intermediate operatively coupling the tubular gripping apparatus to the top drive wherein the structural intermediate is adapted to allow the tubular gripping apparatus to move horizontally relative to the top drive, see column 1, lines 36-68, column 2, lines 1-9, column 2, lines 11-64 and figures 8, 10, 11 and 14.

For claim 21, element 49 in figure 2 represents a fluid conduit.

For claims 22 and 23, see column 8, lines 24-51.

For claim 24, see figures 10, 11 and 14.

For claim 26, see figure 9.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyadjieff.

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For claims 9 and 11, Applicant should note that using a hydraulic motor as a supporting member or having the supporting member be integral with the tool is a matter of design choice wherein no stated problem is solved or unexpected results obtained in using a hydraulic motor for the supporting member or having the support member be integral with the tool versus the arrangement taught by Boyadjieff.

For claim 19, Applicant should note that tools for engaging tubular members are old and well known in the art and it would have been within the general knowledge of one of ordinary skill in the art at the time the invention was made to have selected appropriate tools to engage the tubular members.

***Allowable Subject Matter***

9. Claim 25 is allowed.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-3 and 5-15 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (703) 305-2915. The examiner can normally be reached on M-F (10-7:30) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

eo  
May 31, 2004

A handwritten signature in black ink, appearing to read 'Essama Omgba', is positioned in the lower right area of the page.